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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Graeme John PROUDLER et al.)	Examiner: Thanhnga B. TRUONG
)	
)	Art Unit: 2135
Serial No.:	10/080,476)	
)	Our Ref: B-4515 619561-7
Filed:	February 22, 2002)	30007644-2 US
)	
For:	"INFORMATION SYSTEM")	Date: August 7, 2006
)	
)	Re: <i>Appeal to the Board of Appeals</i>

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from the Final rejection dated March 8, 2006, for the above identified patent application. Appellants submit that this Appeal Brief is being timely filed because the Notice of Appeal was filed on June 7, 2006. Please deduct the amount of \$500.00 for the fee set forth in 37 C.F.R. 1.17(c) for submitting this Brief from deposit account no. 08-2025.

REAL PARTY IN INTEREST

The real party in interest to the present application is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

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RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the present application.

STATUS OF CLAIMS

Claims 1-10 are the subject of this Appeal and are reproduced in the accompanying appendix.

STATUS OF AMENDMENTS

No Amendment After Final Rejection has been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention claimed in claim 1 is directed to an information system comprising an information access point relating to at least one pre-determined geographical area (p. 20 ll. 19-22), said information access point including apparatus for retrieving information relating to computing platforms located within said pre-determined geographical area, together with security attributes of said computing platforms (p. 17 ll. 19-27), said information system being arranged to provide said information to a user upon request (p. 19 ll. 9-21).

The invention claimed in claim 10 is directed to an information system comprising a computing platform having a trusted component (p. 11 ll. 1-12, p. 17 ll. 4-11), apparatus for communicating with a user's portable computing apparatus (p. 18 ll. 12-26), said information system being arranged to geographically retrieve information relating to a pre-determined area and to communicate said information to said user's portable computing apparatus upon request (p. 17 ll. 19-27).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Issue 1: Whether claims 1-10 are patentable under 35 U.S.C. 103(a) over U.S. Pat. No. 6,529,143 to Mikkola et al. in view of U.S. Pat. No. 5,841,868 to Helbig.

GROUPING OF CLAIMS

For each ground of rejection which Appellants contest herein and which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

ARGUMENT

Issue 1: Whether claims 1-10 are patentable under 35 U.S.C. 103(a) over U.S. Pat. No. 6,529,143 to Mikkola et al. in view of U.S. Pat. No. 5,841,868 to Helbig.

In section 3 of the final Office Action of February 6, the Examiner once again rejects claims 1-10 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,529,143 to Mikkola et al. in view of U.S. Pat. No. 5,841,868 to Helbig. In their previous reply, Appellants had explained why they were compelled to disagree with the Examiner's understanding and characterization of these references, the alleged motivation for the skilled person to attempt to combine the references, and the alleged results of such an attempted combination.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP §2142. The Examiner's vague statement that the skilled person would be motivated to do so "since the invention provides positive and definite separation of the user's private information from the host computer, and does not allow this user to gain access to the host computer software unless the private sign-on information is provided during the start-up process" bears not the slightest relation to the present claims. Once again, Appellants respectfully ask: what does "positive and definite separation of the user's private information from the host computer" have to do with the presently claimed system "comprising an information access point relating to at least one pre-determined geographical area, said information access point including apparatus for retrieving information relating to computing platforms located within said pre-determined geographical area, together with security attributes of said computing platforms, said information system being arranged to provide said information to a user upon request?" How is "not allowing this user to gain access to the host computer software unless the private sign-on information is provided during the start-up process" relevant

to the practice of the presently claimed system? Where do the present claims mention a start-up process, host computer software, user's private information, or positive and definite separation of the two at said start-up process? The alleged motivation proffered by the Examiner is simply irrelevant to the present claims and contains absolutely no indication of where exactly the alleged motivation is to be found in the references themselves nor proof that the alleged motivation can be found in the knowledge generally available to one of ordinary skill in the art.

In the present Action, the Examiner alleges to answer the above argument by trodding out the well worn *In re Fine* and *In re Jones* citations and then declaring that "in this case, the combination of teachings between Mikkola and Helbig are sufficient." Appellants respectfully answer, NO THEY ARE NOT. What *is* sufficient is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" as so clearly enunciated in MPEP §2142. The Examiner's vaporous declaration contains no hint of either, and thus does not suffice for a holding of obviousness.

"Second, there must be a reasonable expectation of success... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142. The Examiner has offered not one single detail as to how exactly the skilled person would go about "applying" the teachings of Helbig into the system of Mikkola. Mikkola, as explicitly acknowledged by the Examiner, is directed to means by which a mobile user can automatically be informed of geographical points of interest (POI) that are of interest to him, when specific threshold values are met and where the meeting of these values is monitored in a stationary ground station or stations. Helbig is in a completely unrelated class and concerned with a completely unrelated issue, namely preventing unauthorized physical access to a computer. It is certainly not immediately apparent how the method of preventing unauthorized physical access to a computer of Helbig could be applied to the system of Mikkola, where all communications between the user's terminal and the network occurs automatically and wirelessly. Where exactly would the smart card of Helbig be used in the system of Mikkola? At the server 120? At the operating station 130? The user has no direct physical access to either of these computing platforms. How

exactly would the user of Helbig actually use a smart card, given that the user's terminal communicates with the network exclusively via wireless transmission?

The Examiner's purported acknowledgment that Mikkola "is silent about the security features using within the trusted communication network" begs the question "What trusted communication network?" The very word root "trust" appears not once in Mikkola, nor do "secure," "security," "authorize," etc. Mikkola appears to harbor no worries regarding security and trust whatsoever, as the disclosed method clearly states that when the user arrives in the vicinity of any of the POIs, data on the POI in question are automatically transmitted wirelessly to his terminal. Not even the slightest mention of user identification or validation can be found in Mikkola, and to allege that a skilled person looking to practice this invention would reasonably expect to successfully integrate Helbig therein simply upon reading Mikkola (or Helbig, for that matter) is simply an untenable position and Appellants once again respectfully submit that the Examiner's brief remarks fall far short of the burden imposed by the Rules and the MPEP.

In the present Action, the Examiner completely ignores the above argument aside from some vague assertion that "the broadly claimed language... could very much be read on by practically several prior art" and the mildly puzzling but equally devoid of merit allegation that "broadly term such as, "security attributes", that cites in the claims could lead to broadly assumption by the examiner." Indeed.

"Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142. The Examiner has made no showing of where each and every claimed limitation that is missing in Mikkola may be found in Helbig. For instance, there is absolutely no mention or hint of any information relating to computing platforms located within a pre-determined geographical area nor of security attributes of said computing platforms, as recited by the present independent claims. The geographic points of interest of Mikkola are not computing platforms, and the computing platforms (e.g. server 120) that are mentioned in Mikkola are not described as being located within a pre-determined geographical area. The Examiner appears to completely ignore the security attributes limitation in the present Action, having fallen victim apparently to the dreaded "broadly assumption" mentioned above. The

Examiner's broadly assumptions notwithstanding. Appellants simply cannot find these limitations taught anywhere in either document.

The Examiner appears to at least intend to address this last argument by amiably noting that "besides, Mattison and Miller do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitation."

Appellants thank the Examiner for this pithy review of one of the requirements for patentable novelty, and invite him to finish his thought by explaining who, exactly, are Mattison and Miller, and what these gentlemen (ladies?) have to do with Appellants' claims, given that their names appear nowhere in the previous Action nor in any of the Information Disclosure Statements submitted by Appellants to date. Unless and until the Examiner chooses to divulge this last bit of crucial information, Appellants are quite at a disadvantage in countering the Examiner's "explanation" and respectfully urge the Board to ignore the Examiner's statement as completely irrelevant.

The Examiner finally ventures that "in addition, applicant fails to respond to the prior art, Richton... that Examiner has cited in the conclusion of the office action. The combination of teachings between Richton and Helbig *could* read on the limitations reciting in claims 1 and 10 of the application." Erstwhile, Appellants respectfully note that the Examiner did not rely on Richton in the previous Action, as he clearly stated that Richton was "prior art made of record and not relied upon." Regardless, even if the Examiner intends to now rely on Richton, the passages the Examiner has cited to in Richton fail to meet the three requirements for supporting an obviousness rejection as fully discussed above, and the Examiner makes not even an allusion of an attempt to note specifically where each and every claimed limitation can be found in the combination of Richton and Helbig, where the motivation to combine these two references can be found in either reference or the general knowledge of the skilled persons, and where the expectation of success of the alleged combination can be found in either reference. Thus, Appellants respectfully submit that this is but another groundless "conclusion" that the Examiner

appears to throw up in the air for no reason other than to distract the careful reader from the woeful inadequacy of the teachings of the art on record for the purposes of 35 USC §103.

In view of the above, Appellants respectfully submit that the Examiner has failed to properly substantiate his §103 rejection and that claim 1 is in fact novel and nonobvious over the art of record.

Claims 2-9 depend from claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of claim 1, Appellants submit that claims 2-9 are also novel and nonobvious over the art of record.

Claim 10 "is rejected with the same rationale applied against claims 1, 3, and 4" and Applicants therefore submit that claim 10 is also novel and nonobvious in view of the discussion of claim 1 *supra*.

In view of all the above, Appellants respectfully submit that all pending claims are novel and nonobvious and request the Board to overturn the Examiner's rejection of the claims on appeal and pass the case to allowance.

CONCLUSION



For the many reasons advanced above, Appellants respectfully contend that each claim is patentable and reversal of all rejections and allowance of the case is respectfully solicited.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

August 7, 2006

(Date of Transmission)

Alma Smalling

(Name of Person Transmitting)

Alma R. Smalling

(Signature)

8/7/06

(Date)

Attachments

Respectfully submitted,

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Claims

1. An information system comprising an information access point relating to at least one pre-determined geographical area, said information access point including apparatus for retrieving information relating to computing platforms located within said pre-determined geographical area, together with security attributes of said computing platforms, said information system being arranged to provide said information to a user upon request.

2. A system according to claim 1, wherein said information system is arranged to provide as said information only details and/or a list of public keys of genuine trusted computing platforms within said pre-determined geographical area.

3. A system according to claim 1, wherein said information access point comprises a trusted computing platform.

4. A system according to claim 1, comprising apparatus for communicating or interacting with a user's portable computing apparatus.

5. A system according to claim 4, wherein said apparatus for communicating or interacting a user's portable computing apparatus is arranged to perform said communication or interaction by physical contact or directional wireless communication.

6. A system according to claim 1, incorporating or accompanied by a declaration concerning the trustworthiness of the system.

7. A system according to claim 6, wherein said declaration is capable of interpretation by a user without preprocessing by an information processing system.

8. A system according to claim 1, arranged to verify the identity of a user.

9. A system according to claim 1, arranged to enable a user to perform operations, either locally or remotely, upon the information provided thereby.

10. An information system comprising a computing platform having a trusted component, apparatus for communicating with a user's portable computing apparatus, said information system being

arranged to geographically retrieve information relating to a pre-determined area and to communicate said information to said user's portable computing apparatus upon request.

There is no evidence submitted with the present Brief on Appeal.

U. S. Appln. No. 10/080,476

Brief on Appeal dated August 7, 2006

In support of Notice of Appeal submitted June 7, 2006

Related Proceedings Appendix Page C-1

There are no other appeals or interferences related to the present application.